

Serial No.: 09/418,744

REMARKS

Upon entry of the present Amendment the claims under consideration are 1-26. Claims 1, 8, and 15 are amended. Claims 21-26 are added.

A telephonic interview was conducted between the undersigned attorney and Examiners Elaine Gort and Doug Hess on 15 January 2002. During the interview it was agreed that Claim 8 would contain allowable subject matter if the claim was amended to contain reference to a positively recited printed and published advertisement and publication page. Claims 1, 8 and 15 are amended hereby to positively recite the published advertisement and publication page.

Claims 21-26 are added hereby to more particularly point out the unique features of the invention wherein an image of the advertisement or an image of the published page containing the advertisement, or both, are accessible through association with the invoice statement document. Support for the language of the added claims can be found in the specification at page 4, line 5.

Per Paragraph 2 of the Examiner's Detailed Action of 02 November 2001, Claims 1-20 stand rejected under 35 USC §103(a) as obvious over Goodman et al. (US patent 6,173,217, hereinafter "Goodman"), in view of Bednar (EP 07 45947, hereinafter "Bednar"). Applicant respectfully traverses these rejections.

B

Serial No.: 09/418,744

In general the present invention deals exclusively with methods for constructing a billing statement for advertising customers placing advertisements in printed publications (per the preambles of the present Claims). Goodman deals exclusively with a system whereby an identifying "tag" is inserted into a broadcast signal in the nonviewable or nonauditory portions of the signal (see examples at col. 7 of Goodman). The system of Goodman then has a receiver which detects the tag within the broadcast signal and records the time and tag to verify the time of broadcast of the client advertisement. The subject matter of Goodman, i.e., broadcast advertisement, is ephemeral and time based, whereas the subject matter of the present invention is based on physically printed publications and is image based. Goodman is not concerned with the image *per se*, but only with the tag inserted into the image signal. Thus Goodman is not concerned with, and does not teach, that the advertisement image and the associated identifying tag of Goodman are manipulated according to the steps of the presently claimed method, such as e.g., steps (e) and (f) of amended Claim 1, wherein the first digital document representing the advertisement image (formerly published in print) is found in a first database and copied to an invoice database. Indeed, the copying and storing of video images for later reproduction would be a cumbersome waste of digital storage media which a video advertising scheme such as Goodman would seek to avoid.

B

Serial No.: 09/418,744

Bednar is concerned with the accumulation of invoices from a variety of sources into a central receiving and distribution point and does not deal with the digitizing of associated print advertising or billing therefor. Put another way, the invoicing system of Bednar is not concerned with associating the billing statement with the things actually billed for, as is the case in the present invention.

Per Paragraph 3 of the Examiner's Detailed Action of 02 November 2001, Claims 1-20 stand rejected under 35 USC §103(a) as obvious over official notice that billing for printed advertisements has been done manually and citing the case of *In re Venner and Bowser*, 120 USPQ 192 (CCPA 1958) for the proposition that automating a formerly manual process does not lend patentability to an invention. However, *In re Venner* is not applicable to the present application because the claimed invention has a transformative effect on the nature of the material being manipulated, and the subsequent act of manipulation, when compared to the traditional tear-sheet methodology. It is further believed that the cited principle of the *In re Venner* case used by the Office is mere dicta to the case holding and is a generalization which is so over-broad as to be of extremely limited use and therefore should only be applied, if at all, to fact patterns which are substantially identical to the *In re Venner* case.

Serial No.: 09/418,744

As to the added Claims 21-26, and incorporating the above remarks concerning the differences between broadcast and print advertisements, it can be seen that Goodman is unconcerned with, and does not teach, that the advertisement image and the associated identifying tag are manipulated according to the steps of the presently claimed method, such as, without limitation, e.g.:

Claim 21, step (e), of enabling access to at least the digital document representing the printed advertisement through the second digital invoice document;

Claim 22, the step of enabling access to a digital document representing the printed publication page image containing the advertisement through the second digital invoice document;

Claim 23, steps (c) and (e), of creating a first digital document representing one of the printed advertisement image or the printed publication page with a unique advertisement identifier, and associating the customer identifier with the unique advertisement identifier; and enabling access to the first digital document through the second digital document;

Claim 24, the step of displaying both the first (image) document and the second (invoice) document in human readable form;

Claim 25, steps (b)-(d) and (h), of creating the first (advertisement image) document and the second (page image) document and the third (invoice)

B

Serial No.: 09/418,744

document, and enabling access to the first and second documents through the third document, respectively; and

Claim 26, steps (b)-(d), of creating the invoice document, the advertisement image document, and the page image document, respectively, and step (h), of cross referencing the documents.

For all the foregoing reasons, it is believed that each claim now under consideration is allowable over the art of record. A notice to that effect is earnestly solicited.

If the Examiner detects any issue which the Examiner believes Applicants have not addressed in this response, Applicants' undersigned attorney requests a telephone interview with the Examiner. The undersigned can be reached at (847) 490-1400.

B

Serial No.: 09/418,744

Applicants sincerely believe that the proposed amendments will place
this patent application in condition for allowance.

Favorable consideration is requested.

Respectfully submitted,



Roland W. Norris
Regis. No. 32,799

Pauley Petersen Kinne & Erickson
2800 West Higgins Road, Suite 365
Hoffman Estates, Illinois 60195
PHONE: (847) 490-1400
FAX: (847) 490-1403

B

Serial No.: 09/418,744

Appendix

Version of Claims with Markings to Show Changes Made:

1. (Twice Amended) A method of constructing a billing statement for advertising customers placing advertisements in printed publications, comprising:
 - a. printing and publishing a publication with customer advertisements;
 - [a.] b. establishing a unique customer identifier for each customer;
 - [b.] c. creating a first digital document representing an advertisement image with a unique advertisement identifier and associating the customer identifier with the advertisement identifier;
 - [c.] d. creating a second digital document representing an invoice for advertisements and associating the unique customer identifier therewith;
 - [d.] e. finding the first digital document in a first advertisement database and copying the first digital document to an invoice database;
 - and
 - [e.] f. storing the first and second digital documents in a common file.



Serial No.: 09/418,744

8. (Twice Amended) A method of constructing a billing statement for advertising customers placing advertisements in print publications, comprising:

a. creating a printed advertisement image on a printed publication page;

[a.] b. establishing a unique customer identifier for each customer;

[b.] c. creating a first digital document representing [an] the printed advertisement image with a unique print advertisement identifier and associating the unique customer identifier with the unique print advertisement identifier;

[c.] d. creating a second digital document representing [a] an image of the printed publication page [image with] containing the printed advertisement image and associating the [publication page image] second digital document with the unique print advertisement identifier;

[d.] e. creating a third digital document representing an invoice for [advertisements] the printed advertisement image including specifying an identifier range for invoiced print advertisements;

[e.] f. finding the first digital document by searching the unique customer identifier in a first database and copying the first digital document to an invoice database and listing each found first digital document as a line item on the invoice;

B

Serial No.: 09/418,744

[f.] g. finding the second digital document and copying the second digital document to the invoice database; and

[g.] h. storing the first and second digital documents in a common file associated with the third digital document.

15. (Twice Amended) A method of constructing a billing statement for published advertisements comprising:

a. establishing a unique customer identifier for a customer to be billed;

b. creating a digital billing invoice document and associating the digital billing invoice document with the unique customer identifier and storing the digital billing invoice document in an invoice file;

c. creating a printed advertisement image on a printed publication page;

d. creating a digital advertisement document representing the printed advertisement image with a unique advertisement identifier and associating the unique customer identifier with the unique advertisement identifier and storing the digital advertisement document in an advertisement database;



Serial No.: 09/418,744

e. creating a digital publication page representing the printed publication page, with the digital advertisement document thereon, and having a unique page identifier; and associating the unique page identifier with the unique advertisement identifier and storing the digital publication page document in a publication page database;

f. searching for digital advertisement documents in the advertisement database according to the customer identifier, identifying digital advertisement documents according to the customer identifier, and copying identified digital advertisement documents to the invoice file;

g. searching for digital publication pages associated with the digital advertisement documents in the publication page database and copying the associated digital publication pages to the invoice file; and

h. cross referencing the billing invoice, advertisement, and publication page digital documents in the invoice file.